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Atty. Dkt. No. 038441-0104

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert W. KILLICK et al.
Title: ADJUVANT COMPOSITION FOR
CHEMICALS USED IN
AGRICULTURE
Appl. No.: 09/831,301
Filing Date: 05/08/2001
Examiner: Alton Nathaniel Pryor
Art Unit: 1616

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the election of species requirement set forth in the Office Action mailed November 27, 2002.

In response to the Office Action, Applicants hereby provisionally elect for examination, with traverse, petroleum fraction as a species of the lipophilic solvent, ammonium sulfate as a species of the lipophobic plant nutrient and quaternary cationic emulsifiers as a species of the cationic emulsifier. Claims 1-6, 14-30, and 32-40 read on the elected species.

REMARKS

Introduction

The Examiner has required election of a specific lipophilic solvent, a specific lipophobic plant nutrient and a specific cationic emulsifier, stating that the species are patentably distinct. For the reasons set forth below, the election of species requirement should be withdrawn.

While the Commissioner may require restriction if two or more independent and distinct inventions are claimed in one application (35 U.S.C. § 121), M.P.E.P. § 803 directs as follows (emphasis added): "If the search and examination of an entire

application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." In this application, the Examiner has searched and examined the claims on the merits four times, including all the distinct species alleged to be set forth in claims 1-30 and 32-45. Thus, this directive should be followed by the Examiner in the above-captioned case and the entire application should continue to be examined.

Procedural History

The above-captioned application was filed on May 8, 2001. On July 30, 2001 the PTO issued a first non-final Office Action rejecting claims 1-4, 11, 15, 16, 18-20, 22, 24, 27-32, 39 and 40 and indicating that claims 5-10, 12-14, 17, 21, 23, 25, 26, 34-38 and 41-45 contained allowable subject matter. At the time of the PTO's rejection, claims 1-45 contained each of the species which the Examiner now restricts. In response to the July 30, 2001 Office Action, applicants argued against the rejections of record.

On January 2, 2002 the PTO issued a second non-final Office action again rejecting claims 1-4, 11, 15, 16, 18-20, 22, 24, 27-30, 32, 39 and 40 and confirming that claims 5-10, 12-14, 17, 21, 23, 25, 26, 34-38 and 41-45 contained allowable subject matter. At the time of the PTO's January 2, 2002 rejection, the claims contained each of the species which the Examiner now restricts. In response to the PTO's January 2, 2002 Office Action, applicants argued against the rejection of record. At page 2 of the Response, Applicants affirmatively stated that "[t]he present invention is directed to [a] homogeneous liquid adjuvant used in agriculture which comprises a lipophilic solvent, a lipophobic plant nutrient and a cationic emulsifier..." (emphasis added). Thus, Applicants made it clear that the claimed composition included (1) a lipophilic solvent, (2) a lipophobic plant nutrient and (3) a cationic emulsifier. It is unfair for the Examiner to allege at this late date in the prosecution that an election of species is appropriate because the amendment of October 31, 2002 now requires that the invention include these clearly set forth adjuvants.

On June 18, 2002 the PTO issued a final Office Action on the same grounds as the July 30, 2001 and January 2, 2002 Office Actions. Applicants filed a Response to the June 18, 2002 final Office Action on September 18, 2002, again clearly setting

forth that "[t]he present invention is a homogeneous adjuvant comprising four elements: (a) a lipophilic solvent; (b) at least one lipophobic plant nutrient; and (c) at least one cationic emulsifier that (d) acts as a coupling agent between the lipophilic solvent and the lipophobic plant nutrient."

On October 8, 2002 the PTO issued an Advisory Action. The Advisory Action was the first time that the PTO alleged that "according to instant claim language 0% lipophobic solvent can be present." Moreover, this interpretation is directly in contrast to representations that applicants clearly set forth in the prosecution history as early as January 2, 2002 and which is clearly set forth in the application as filed. That is, the claimed composition includes "(a) a lipophilic solvent; (b) at least one lipophobic plant nutrient; and (c) at least one cationic emulsifier . . .".

In an effort solely to further prosecution of this application to allowance, Applicants submitted a second Response after the final Office Action amending the claims to clarify any perceived ambiguity and to address the Examiner's perceived misconception of the claimed invention, which was first raised in the October 8, 2002 Advisory Action. In response to this filing, the PTO has now issued, for the first time, a requirement for election of species requesting that Applicants elect a specific lipophilic solvent, a specific lipophobic plant nutrient and a specific cationic emulsifier. The Examiner's rationale for this request is that the claims now affirmatively recite that the lipophilic solvent, that lipophobic plant nutrient and the cationic emulsifier are each present in the composition. The Examiner is woefully late in his request.

These claims contain species which were claimed at the time the application was filed and which were searched and examined four times. At no time prior to November 27, 2002 did the PTO issue a restriction or election. Thus, the above-captioned application has been pending for **eighteen (18) months**, and applicants have received two complete non-final Office Actions on the merits, a final Office Action on the merits and an Advisory Action, before the PTO required the election of species, without justification.

The Restriction Requirement Should Be Withdrawn

M.P.E.P. § 811 recites that the examiner should make a restriction requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon

as the need for a proper requirement develops. See, M.P.E.P. § 811. In this case, the Examiner has searched and examined all of the species originally claimed when the application was filed in May, 2001. At this stage of the prosecution, is no serious burden on the Examiner to examine all species together. The Examiner need only update the search made before the June 18, 2002 final Office Action. Therefore, the Examiner should continue examination of claims 1-30 and 32-45 on the merits, even though the application may include claims to distinct or independent inventions. See, M.P.E.P. § 803.

Conclusion

In view of the foregoing, it is respectfully urged that claims 1-30 and 32-45, should be examined together. An early notice of allowance is earnestly solicited. Should there be any questions, Examiner Pryor is courteously invited to contact the undersigned at the telephone number shown below.

Respectfully submitted,

Date December 24, 2002

By Alan I. Cantor

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